

REMARKS

Status of the Claims

Upon entry of the amendment above, claims 14-44 and 47-64 will remain pending, claims 14, 15, 24, 29, 30, 44, and 58 being independent.

Summary of the Office Action

Claim 24 is indicated as containing allowable subject matter but is objected to for depending upon a rejected claim.

Claims 29, 32,-34, 42, and 53 are rejected under 35 USC §103(a) as being unpatentable over PHILLIPS et al. (U.S. Patent No. 3,783,534, hereafter "PHILLIPS") in view of BOUGHEY (U.S. Design Patent No. 157,124).

Claims 14-23, 25-28, 30, 31, 35-41, 43, 44, 47-52, and 54-64 are rejected under 35 USC §103(a) as being unpatentable over PHILLIPS in view of ELLIS et al. (U.S. Patent No. 3,206,874, hereinafter "ELLIS") and BOUGHEY.

Response to the Office Action

A. Summary of Amendment

In the amendment above, Applicant has rewritten allowable dependent claim 24 in independent form so as to preclude, after appeal if necessary, subsequent cancellation of claim 24 pursuant to MPEP §1214.06(I)(A). As amended, claim 24 includes the subject matter of parent claims 15 and 20.

While making that amendment, Applicant noticed terminology in parent claim 20 which could be clarified and, therefore, Applicant has introduced an amendment to claim 20, which amendment has been incorporated into claim 24. Specifically, "a cover" has been changed to "the cover" (in lines 2-3 of claim 20), and "insert" has been changed to "shoe" (in line 4 of claim 20), inasmuch as the cover covers the shoe rather than the insert.

Finally, a cosmetic revision has been made to the end of the claim, with regard to the

cover being caused to cover the front surface of the shoe "upon application of a force by a user" (rather than "by manual thrust or traction from a user").

Entry of these minor and generally cosmetic amendments is kindly requested. The substance of these amendments are intended merely to improve their form; they have not been made to bolster Applicants' positions or to weaken the Examiner's rejections.

B. Summary of the Invention

The invention relates to an article of footwear and, in a particular embodiment, a shoe that includes a high upper, *i.e.*, an upper that extends above the ankle of the wearer and which is positioned along the lower leg of the wearer, such as in front of the tibia of the wearer.

A particular field of endeavor to which the invention is directed is that of snowboarding. As explained in the background and summary sections of the specification of the instant application, current snowboard boots (and other sports boots) must satisfy various demands of the user, some of which are contradictory. For example, a boot should be comfortable for the user and, for example, should enable him/her to perceive plantar sensations during the sport, such as during snowboarding. On the other hand, if the upper of the boot is not sufficiently rigid, the transmission of forces from the rider to his/her board, enabling the board to be controlled, is less than optimum.

According to the invention, then, at least the front-to-rear rigidity of the boot is enhanced by means of a cover, *i.e.*, a front spoiler, whereby the tibial support zone of the boot is less easily flexed about the flexion fold (*i.e.*, the flexion crease) of the boot toward the front end zone of the boot. Thus, with the cover in place on the boot, extending from at least the front end zone of the boot and into the flexion fold zone, the cover interferes with the free flexing of the boot that would be possible without the cover.

Further, as explained in paragraph 0012 of the specification, with the rigidity of the cover, or front spoiler, in the context of snowboarding, the rider is able to transmit forces (such

as for steering the board) from his/her lower leg to the board, via the rigid cover/spoiler to the sole of the boot.

C. Withdrawal of Rejection Under 35 USC §103(a) over PHILLIPS and BOUGHEY

Applicant requests that the two grounds of rejection, both based upon the combination of PHILLIPS and BOUGHEY, the second rejection additionally relying upon ELLIS, be reconsidered and withdrawn at least for the reasons presented below. The rejection of claims 29, 32-34, 42, and 53 for obviousness over the proposed combination of PHILLIPS and BOUGHEY will first be addressed.

As a preface to the following arguments, Applicant's undersigned representative acknowledges the quality of Primary Examiner Mohandes's work over the several years she has been engaged in examining applications of Applicant's company and, therefore, he endeavors to traverse rejections only if he can do so with conviction. The rejections to which Applicant here responds are believed to be of that type. Accordingly, with respect to this particular application, Applicant kindly requests that she reconsider and withdraw what are believed to be untenable positions in light of the limitations presented in the rejected claims for the reasons advanced below.

1. PHILLIPS Does Not Disclose a Rigid or Semi-Rigid Tongue that Covers the Flexion Fold and Extends Forwardly to the Front End Zone

PHILLIPS discloses an off-road motorcycle boot intended to protect the cyclist's shin and lower leg against injury by being struck by items such as brush during trail riding. See, e.g., column 3, lines 34-39 of PHILLIPS.

To provide such protection (see column 2, lines 25-52), PHILLIPS equips his boot with rigid strips 42 and 43 (see Fig. 2) which are embedded between two layers of the sides 20 of the upper 14 of the boot, extending between the ankle and knee. In addition, PHILLIPS equips the tongue 30 of his boot with a rigid strip 40 between two layers of material which make up the tongue for protecting the shin (column 2, lines 39-40).

Near the bottom of page 2 of the Office action, the rejection includes the assertion that the cover of PHILLIPS is "more rigid than said upper front surface and said flexion fold zone of the shoe, since the cover is more rigid than the upper front surface (specially when made of metal)" and, therefore, "it will inherently interfere with the free flexing of the shoe to some extent."

Applicant respectfully disagrees.

Independent claim 29, which stands rejected as being anticipated by PHILLIPS, specifies that the cover is rigid or semi-rigid at the flexion fold zone (i.e., at the instep area) to increase flexural rigidity in the flexion fold zone. In fact, Applicant describes the cover to be rigid or semi-rigid at the front end zone of the article of footwear of the claim.

PHILLIPS does not teach or suggest that the tongue 30, identified in the Office action as a "protective cover," extends down to the flexion fold zone, nor to the front end zone. In fact, PHILLIPS only describes "rigid strip" 40 (which is said to be "secured between two layers of material which make up the tongue 30" – column 2, lines 31-32) as forming "an effective shield for the wearer's shin", i.e., the front of the tibia.

As far as "inherently interfer[ing] with the free flexing of the shoe to some extent" (see bottom of page 2 of the Office action), in column 2, lines 42-44, PHILLIPS explains that "[t]he lower edge of strip 42 preferably is just above the wearer's ankle **to allow freedom of movement**" (emphasis added). Strip 42 is described as being positioned at the outside of the lower leg, with strip 43 – described as "corresponding in size, shape and position to strip 42" (column 2, lines 44-45) – being positioned at the inside of the lower leg. Now, although PHILLIPS describes the outer and inner strips 42, 43 having a lower edge above the ankle to allow freedom of movement, he links the tongue strip 40 with the side strips by saying that the strip 40 "forms an effective shield for the wearer's shin, **and strip 42 does likewise for the outside of the lower leg**" (column 2, lines 39-41).

Therefore, Applicant respectfully submits, the three strips 40, 42, 43 are positioned to surround the lower leg – i.e., not the flexion fold or beneath the flexion fold – to protect the lower leg, while allowing freedom of movement.

Furthermore, the need to allow freedom of movement for the foot of a motorcyclist would be readily apparent, inasmuch as, while needing protection against injury to the shin and lower leg by being struck by items such as brush during trail riding, as noted above by PHILLIPS, the cyclist – at the same time – needs freedom of movement to allow his/her foot to flex relative to the lower leg for the purpose of operating the shift lever on one side of the motorcycle and the rear brake lever on the other side. Certainly, rigidifying the pivot connection between the foot and lower leg would be contrary to PHILLIPS' disclosure.

For the foregoing reasons, Applicant kindly requests that the rejection be withdrawn.

2. BOUGHEY Fails to Disclose a Shoe Cover Articulated Relative to the Sole

Independent claim 29 (as do independent claims 14, 15, 44, and 58, as mentioned below in connection with the second ground of rejection) specifies that the cover is connected to the sole by being articulated thereto between the top and bottom of the sole.

In PHILLIPS, the tongue 30 “is hingedly attached to the boot 10 near the toe 16. An extending portion of the tongue 30 is covered by a triangular metal plate³² and secured to the boot by rivets 34” (column 2, lines 13-16). As shown in the drawings, the rivets are on top of the forefoot region of the upper. The cover is not connected to the sole and is not articulated to the sole.

The sentence bridging pages 2 and 3 of the Office action admits that “Phillips does not disclose the cove being fixed to the sole between the top and bottom of the sole for articulation relative to the sole.”

Therefore, BOUGHEY is newly relied upon in the final rejection, the rejection explaining “Boughey ‘124 discloses a shoe and a cover for flexural stiffening of the shoe

where the cover is fixed between the top and bottom of the sole for better articulation relative to the sole" (page 3, lines 2-4 of the Office action).

Applicant respectfully disagrees.

BOUGHEY's "foot shield" is not articulated to a shoe. BOUGHEY is a design patent, which, as explained in MPEP §1502, "consists of the visual characteristics embodied in or applied to an article." Further, "the subject matter of a design patent application may relate to the configuration or shape of an article, to the surface ornamentation applied to an article, or to the combination of configuration and ornamentation."

As a result, BOUGHEY provides a visual depiction of a "foot shield body," without any description of movement, whether articulated movement or otherwise, relative to the sole of a shoe.

At the lower rear of the foot shield of BOUGHEY is a relatively small circle which, perhaps, has been assumed by the Examiner to be related to some kind of pivot connection. However, if one were to so engage in speculative assumptions, Applicant submits that it would be more logical to assume the small circle is related to a fastener whose purpose is to fix the foot shield in place on a shoe ***against movement relative to the shoe***. That is, unlike Applicant's illustrated embodiment of his invention, whereby the cover is provided to be articulated at the front, so that the cover can be pivoted forwardly away from the front of the boot, the small circle of BOUGHEY is provided at the ***rear***. Thereby, in what manner and for what purpose would the BOUGHEY's foot cover be articulated? If it were to pivot rearwardly, it would appear that the rear edge of the foot shield would immediately impinge upon the top of the instep region of the shoe. Not only could such movement prove painful to the wearer (if the foot shield were rigid/semi-rigid, of which there is no teaching), there would appear to be no reason for the foot shield to pivot in that manner, i.e., rearwardly. Such pivoting would not seem to facilitate access to the shoe lacing zone or to facilitate removal of the shoe, for example.

As explained in *In re Warner*, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967):

The Patent Office has the initial duty of supplying the factual basis for its rejection. It may not, because it may doubt that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in its factual basis.

Applicant respectfully submits that, in newly relying upon BOUGHEY, the Office has resorted to speculation and unfounded assumptions to support the rejection. For this additional reason, therefore, Applicant kindly requests that the rejection be withdrawn.

3. BOUGHEY Fails to Disclose a Shoe Cover for Flexural Stiffening of the Shoe

As mentioned above, the rejection explains that “Boughey ‘124 discloses a shoe and a cover for flexural stiffening of the shoe ...” (page 3, line 2 of the Office action).

Again, Applicant respectfully disagrees.

In the context of independent claim 29, for increasing flexural rigidity, the device of the invention includes a rigid or semi-rigid “cover covering said flexion fold zone of said article of footwear ...” (claim 29, lines 6-7). Thereby, flexing of the foot relative to the tibia is rigidified, for the purpose explained above regarding the summary of the invention.

Although BOUGHEY entitles his design a “foot shield body,” there is no disclosure of it covering a flexion zone of a shoe. It would appear, to the contrary, that the foot shield merely lies atop the forefoot and toward the instep.

For this additional reason, reconsideration and withdrawal of the rejection is kindly requested.

4. Modifying PHILLIPS by Means of BOUGHEY Would be Contrary to PHILLIP's Disclosure

Further, even if BOUGHEY were to have provided a description of articulated movement relative to the sole of a shoe, one skilled in the art would not have been motivated to modify the boot of PHILLIPS in a way that would have resulted in Applicant's invention.

PHILLIPS describes the need to have "freedom of movement" between the lower leg and the foot, as noted above. By modifying the boot of PHILLIPS to "fix the cover ... between the top and bottom of the sole", as suggested on page 3, lines 5-7 of the Office action, would adversely affect the stated purpose of providing freedom of movement.

As explained in MPEP §2143.01, if proposed modification would have rendered the prior art invention being modified unsatisfactory for its intended purpose, then there would have been no suggestion or motivation to make the proposed modification. *In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984).

For this additional reason, reconsideration and withdrawal of the rejection is kindly requested.

D. Withdrawal of Rejection Under 35 USC §103(a) over PHILLIPS, ELLIS, and BOUGHEY

Applicant requests that the rejection of claims 14-23, 25-28, 30, 31, 35-41, 43, 44, 47-52, and 54-64 for obviousness over the proposed combination of PHILLIPS, ELLIS, and BOUGHEY be reconsidered and withdrawn.

In short, the rejection of the aforementioned claims should be withdrawn at least for reasons advanced above in connection with the rejection based upon PHILLIPS and BOUGHEY. ELLIS, added in this ground of rejection, is relied upon for a showing of a cover "which extends to the front of the toe to provide more protection in the toe area" (page 4, lines 2-3).

1. PHILLIPS Does Not Disclose a Rigid or Semi-Rigid Tongue that Covers the Flexion Fold and Extends Forwardly to the Front End Zone

As mentioned above, PHILLIPS does not teach or suggest that the tongue 30, identified in the Office action as a "protective cover," extends down to the flexion fold zone, nor to the front end zone. Instead, because of the need to allow freedom of movement, as explained in Section C1 above, the lower edges of the rigid strips 40, 42, 43 are above the ankle.

In contrast, independent claims 14, 15, 30, 44, and 58 call for the cover “within said flexion fold zone”; “extend ... through a flexion fold zone”; “covering said flexion fold zone”; “cover said flexion fold zone”; and “extending ... in said flexion fold zone.”

Reconsideration and withdrawal of the rejection, therefore, is requested for this reason.

2. BOUGHEY Fails to Disclose a Shoe Cover Articulated Relative to the Sole

Independent claims 14, 15, 44, and 58, like independent claim 29 discussed above, as well as dependent claims 63 and 64, specify that the cover is connected to the sole by being articulated thereto between the top and bottom of the sole.

In PHILLIPS, the tongue 30 attached to the top of the forefoot of the upper. Therefore, reliance is had on newly cited BOUGHEY. However, as explained above, BOUGHEY’s “foot shield” is not articulated to a shoe. BOUGHEY provides a visual depiction of a “foot shield body,” without any description of movement, whether articulation movement or otherwise, relative to the sole of a shoe.

Therefore, reliance upon BOUGHEY necessitates speculation and unfounded assumptions to support the rejection. For this additional reason, therefore, Applicant kindly requests that the rejection be withdrawn.

3. BOUGHEY Fails to Disclose a Shoe Cover for Flexural Stiffening of the Shoe

The rejection explains that “Boughey ‘124 discloses a shoe and a cover for flexural stiffening of the shoe ...” (page 4, lines 3-4 of the Office action).

As mentioned above (in Section C3) in connection with the rejection of independent claim 29, although BOUGHEY entitles his design a “foot shield body,” there is no disclosure of it covering a flexion zone of a shoe. It would appear, to the contrary, that the foot shield merely lies atop the forefoot and toward the instep.

For this additional reason, reconsideration and withdrawal of the rejection is kindly requested.

4. Modifying PHILLIPS by Means of BOUGHEY Would be Contrary to PHILLIP's Disclosure

Further, even if BOUGHEY were to have provided a description of articulated movement relative to the sole of a shoe, one skilled in the art would not have been motivated to have modified the boot of PHILLIPS in a way that would have resulted in Applicant's invention, for reasons explained above in connection with the rejection of independent claim 29 (in Section C4).

As pointed out above, PHILLIPS describes the need to have "freedom of movement" between the lower leg and the foot, as noted above. By modifying the boot of PHILLIPS to "fix the cover ... between the top and bottom of the sole", as suggested on page 4, lines 9-12 of the Office action, would adversely affect the stated purpose of providing freedom of movement.

For this additional reason, reconsideration and withdrawal of the rejection is kindly requested.

5. None of PHILLIPS, ELLIS, and BOUGHEY Teach or Suggest the Subject Matter of Claim 30

Independent claim 30 specifies that the cover comprises a continuous rigid or semi-rigid material that extends continuously from within the upper part of the cover, through the intermediate part, and within the lower part. In addition, claim 30 specifies that the lower part of the cover is then connected to the sole, so that the wearer of the boot can transmit forces from his/her lower leg to the sole of the boot. None of PHILLIPS, ELLIS, and BOUGHEY, nor any reasonable combination of PHILLIPS, ELLIS, and BOUGHEY teach or suggest the subject matter of claim 30.

As mentioned above, the continuous rigidity of the cover – or front spoiler – from the tibia zone to the sole is beneficial to achieve the object of the invention of enabling transmission of forces, particularly during snowboarding. There would have been no reason to have modified the boots of PHILLIPS or ELLIS in a way that would have resulted in

Applicant's invention, particularly in view of the different objectives of those two boots. For example, PHILLIPS describes the need to have freedom of movement for at his ankle between the tibia and the foot. In addition, PHILLIPS demonstrates that, if he finds a need to protect his toe, he provides a "[s]teel toe 39 ... in the usual manner of safety boots" (column 2, lines 28-29), which would not compromise his need to ensure freedom of movement of his lower leg relative to his foot. To do otherwise, i.e., in the manner suggested in the rejection to reject claim 30, would be contrary to a purpose of PHILLIPS' disclosure.

6. None of PHILLIPS, ELLIS, and BOUGHEY Teach or Suggest the Subject Matter of Dependent Claims 27, 43, and 48

In dependent claims 27, 43, and 48 Applicants call for a plurality of covers having different rigidities. The rejection references column 3, lines 2-6 of ELLIS as suggesting this additional feature of Applicant's claimed invention, on the theory that it amounts to "mere duplication of the essential working parts of a device" which "involves only routine skill in the art." The rejection then references *St. Regis Paper Co. v. Bemis Co.*, 198 USPQ 8 (7th Cir.).

Applicant requests this rejection, which relies upon a Seventh Circuit decision, rather than upon those of the Court of Appeals for the Federal Circuit or its predecessor court (Court of Customs and Patent Appeals), be withdrawn at least inasmuch as it fails to provide an explanation of a motivation for the modification of PHILLIPS, ELLIS, or BOUGHEY.

In addition, ELLIS merely provides a mention that its guard flap can be made from any of a particular number of metals or other rigid materials. ELLIS fails to provide any teaching or suggestion to provide a plurality of covers for the same shoe.

SUMMARY AND CONCLUSION

Entry of the amendment is requested, together with reconsideration and withdrawal of the rejections for reasons of record and for additional reasons advanced above.

Payment is attached for an extension of time for two months and for a claim fee. No additional fee is believed to be due at this time. However, the Commissioner is authorized

to charge any fee required for acceptance of this reply as timely and/or complete to Deposit
Account No. 19-0089.

Any comments or questions concerning this application can be directed to the
undersigned at the telephone or fax number given below.

Respectfully submitted,
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